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OFFICE OF PETITIONS

In re Application of
Anthony A. Barretto et al.
Application No. 10/827,557
Filed: April 20, 2004
Attorney Docket No. 33631.1
Title: SUBSTRATE ALIGNMENT
METHOD AND APPARATUS

DECISION ON PETITION

This is a decision on the "Petition to Accept Allegedly Missing Parts," filed July 19, 2004, requesting that the above-identified application be accorded a filing date of April 20, 2004, with pages 2, 4, and 17 of the specification as part of the original disclosure of the application.

The application was deposited on April 20, 2004. However, on June 30, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice of Omitted Item(s) in a Nonprovisional Application – Filing Date Granted" (notice) stating that the application had been accorded a filing date, and advising applicants that it appeared as though the application was deposited without pages 2, 4, and 17 of the specification. The notice set a two-month period for response.

On July 19, 2004, the instant petition was filed, along with pages 2, 4, and 17 of the specification, as well as a copy of the notice. No declaration attesting that these pages are the same as those which were in the parent application has been provided. The petition fee has been charged to Petitioner's Deposit Account, as authorized in the petition.

Petitioner contends that these three (3) pages were constructively included on filing, through incorporation by reference.

The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. The preliminary amendment to the specification indicates that the instant application is a divisional of application 10/066,295, and the Utility Patent Application Transmittal sheet

indicates that the entire disclosure of the parent application is incorporated by reference.

Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition (emphasis added) provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

For these reasons, the petition under 37 CFR §182 is **DISMISSED**.

The application will receive a filing date of April 20, 2004. However, the 3 pages of specification submitted with the instant petition will not be entered. If petitioner desires for the examiner to consider the missing pages which were not submitted as part of the original disclosure, then petitioner may submit these pages via an amendment. Any such amendment will, of course, be reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

The original application papers will include only those application papers present on the date of deposit.

The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of April 20, 2004, using only the application papers filed on that date.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



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¹ See MPEP 608.02(a).